

Appl. No. 09/821,581
Amdt. Dated August 21, 2003
Reply to Office Action of May 21, 2003

• • R E M A R K S / A R G U M E N T S • •

The Official Action of May 21, 2003 has been thoroughly studied. Accordingly, the following remarks are believed to be sufficient to place the application into condition for allowance.

Claims 1-10 are pending in this application.

Claims 1-10 stand provisionally rejected under 35 U.S.C. §101 as claiming the same invention as copending Application Serial No. 09/925,767.

Applicant submits that the claims of the present application are not of the same scope as the claims of copending Application Serial No. 09/925,767.

A comparison of independent claims of both applications is as follows:

Present Application

Serial No. 10/021,847

Claim 1:

Claim 1:

A filter device for coffee or the like comprising:
an open frame in a short tubular shape;
a blind-end frame in a short tubular shape
having a larger diameter than said open frame,
both said frames being formed of sheet material
having predetermined rigidity;

A filter device for coffee or the like comprising:
a container body consisting of an open
frame formed of sheet material having
predetermined rigidity, and a blind-end frame,
including an annular bottom member, being
joined with said open frame so as to be foldable

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a body part in a tubular shape of truncated cone formed of sheet material having predetermined rigidity and flexibility which is deformable and has shape retaining ability, said open frame and said blind-end frame being arranged above and below, and integrally connected by way of said body part thereby to compose a container body substantially in a shape of truncated cone in its outer shape; and

into said open frame, said blind-end frame being formed of sheet material having predetermined flexibility; and

a filter chamber for enclosing substance to be extracted, being mounted with a filter on said annular bottom member,

wherein said blind-end frame is foldable into said open frame together with said filter chamber and said open frame provides a reinforcing structure that surrounds an outer upper portion of the blind-end frame when the filter is unfolded.

a store room for enclosing substance to be extracted such as ground coffee or the like which is continuously provided in a bottom of said blind-end frame,

wherein while not in use, said body part is adapted to be invertibly folded and housed inside said blind-end frame together with said open frame by means of flexibility of said body part thereby to contract said container body, and while in use, said body part is expanded by pulling out of said open frame from said blind-

Claim 14:

A filter device for coffee or the like which is constructed;

by forming an open frame in a short tubular shape of sheet material having predetermined rigidity,

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end frame, whereby said container body is expanded and restored to an original cup-like shape.

by extending a body part of a blind-end frame extending downward from a lower edge of said open frame thereby to form a cup-shaped container body, said blind-end frame being formed of deformable sheet material provided with shape retaining characteristic having predetermined rigidity and flexibility; and

by continuously forming a filter chamber for enclosing substance to be extracted such as ground coffee in a bottom of said blind-end frame via a filter, wherein when it is not in use, said filter chamber is pushed into said open frame while said body part of said blind-end frame is flexed and deformed to fold and contract said blind-end frame, and when it is in use, said body part is flexed to expand said blind-end frame thereby enabling said container body to be expanded and restored to a cup-like shape, and said filter

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chamber to be pulled downward.

From the above comparison the Examiner will note that the scope of these two claims is not the same at all. Claim 1 of present application recites a "body part" which is separate from the open and blind-end frame elements. Such an element is not found in claim 1 of copending Application Serial No. 09/925,767. The present application further does not include claims directed to the construction of a filter device. Other differences in the scope of the two claims can be seen above. Also copending Application Serial No. 09/925,767 does not require that the diameter of the blind-end frame be larger than the diameter of the open frame.

Based upon a comparison of the independent claims of the present application and copending Application Serial No. 10/021,847 it is submitted that the double patenting rejection under 35 U.S.C. §101 is improper and should be withdrawn.

Claims 1-5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,867,993 to Nordskog in view of Japanese reference No. 5-40843 (JP'943).

Claims 6-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nordskog in view of JP'843 and further in view of U.S. Patent No. 4,520,716 to Hayes.

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Nordskog in view of JP'843 and further in view of U.S. Patent No. 6,103,116 to Koslow et al.

For the reasons set forth below, it is submitted that all of the pending claims are allowable over the prior art of record and therefore, each of the outstanding prior art rejections of the claims.

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Favorable reconsideration by the Examiner is earnestly solicited.

The Examiner has relied upon Nordskog as teaching a blind frame 20, an open frame 38, a body part 30, and a store room 14.

The Examiner concedes that Nordskog does not teach connecting the blind frame with the open frame by a deformable body part which would fold completely inside the blind frame in Fig. 7, "where the blind frame is larger than the open frame, as in instant claim 1."

The Examiner has relied upon JP'843 as teaching a coffee filter with open frame smaller and the blind frame connected with a collapsible body part that part that folds completely inside.

In combining the teachings of Nordskog and JP'843 the Examiner has taken the position that:

It would be obvious....to use the teaching of JP'843 in the teaching of Nordskog (993) to have the blind frame and open frame connected by a collapsible body to obtain extra hold-up volume in the filter.

It is submitted that the combination of Nordskog and JP'843 proposed by the Examiner does not render applicant's claimed invention obvious under 35 U.S.C. §103.

The Examiner has relied element 38 of Nordskog as reading on applicant's claimed open frame. However, element 38 of Nordskog is stated to be "slide guide side rims" which "are used to fit into standard guideways (not shown) in a coffee or other similar hot beverage making machine."

The element which the Examiner construes to be body part 30 does not fold up into side rims 38.

The Examiner refers to Fig. 7 of Nordskog as teaching an embodiment in which the blind frame has a larger diameter than the open frame.

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In Fig. 7 it is assumed that the Examiner is construing portion 36b of side wall 20 to be applicant's claimed blind frame and portion 32b of side wall to be applicant's open frame.

The Examiner's proposal to "use the teaching of JP'843 in the teaching of Nordskog (993) to have the blind frame and open frame connected by a collapsible body" would require that the lower portion or the Examiner's "blind frame" to smaller in diameter than the upper portion or the Examiner's open frame.

That is, in order to modify Nordskog to have the lower portion of the filter fold up into the upper portion as taught by JP'843, the lower portion would necessarily have to have a smaller diameter. See Figs. 1 and 2 of JP'843.

Applicant's independent claim 1 requires that the blind-end frame has a larger diameter than the open frame.

Accordingly, the Examiner's proposed combination fails to meet all the limitations of applicant's independent claim 1.

Therefore, the proposed combination does not render applicant's claimed invention obvious under 35 U.S.C. §103.

The Examiner has relied upon Hayes as teaching a "reinforcing frame forming a cup holder in a coffee maker filter."

The Examiner has relied upon Koslow et al. as teaching a non-woven fabric material for the filter material of a coffee filter.

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Neither the Examiner's reliance upon Hayes or Koslow et al. addresses or overcome the deficiencies in the combined teachings of Nordskog and JP'843 discussed above.

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicant's claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejections of the claims should hence be withdrawn.

Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

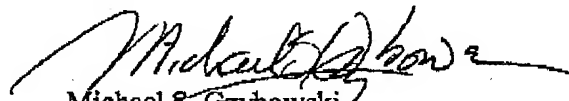
It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

If upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved, the Examiner is invited to contact applicant's patent counsel at the telephone number given below to discuss such issues.

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To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,



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